

REMARKS

The Applicant respectfully believes that the final Office action mailed on 16 January 2004 (Paper No. 8) is a premature final Office action for the following reasons.

The Applicants respectfully believe that the final Office action mailed on 16 January 2004 (Paper No. 8) is a premature final Office action because in the previous response to paper number 6, the Applicant had asked the Examiner that further clarification by Examiner would be very helpful to the Applicant. Specifically and respectfully, the response stated that the Examiner must provide the completeness in the rejection under 37 C.F.R. §1.104(b) and (c) in formulating the rejection. As mentioned in 37CFR §1.104 (c)(2), "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." Concerning certain rejections, a string of passages were quoted without any particular reference to the particular parts being relied on. The particular parts relied upon were not mentioned and therefore it makes it difficult for the Applicant to respond to the Examiner's rejection. Quoting large portions of the text does not always take the place of showing the particular part especially when it is not entirely clear what particular parts are being referenced from the body of text quoted.

For example, in paper no. 6, the Examiner referred to the limitation of the signal dispensing unit as for example in figures 2-5, col. 3, lines 22-40, all of col. 5 and col. 6, lines 25-47 of Cheney (US Patent 6,519,283). Looking at all of those figures 2 through 5 and portions of col. 3, 6 and all of col. 5, it was not clear at all what the Examiner was referring to and basically, the Applicant was forced to guess as to what the Examiner was referring to in his 35USC§102 rejection. Figures 2

through 5 show a wide variety of elements and the sections mentioned by the Examiner provide no further clarification of what particular part the Examiner is relying on in the rejection.

In addition, as another example, in paper no. 8, the part being relied upon for the element of the signal processing unit was further ambiguous, the Examiner again referred to figures 2 through 5, all of column 5 and col. 6, lines 25-67. Col. 5 and col. 6, lines 25-67 basically discusses the multitude of elements shown in figures 1 through 4 with no clear indication of what particular part was being relied upon.

In paper no. 8, the Examiner did provide some clarification by mentioning some (but not all) of the particular parts being relied on in the remarks section (pages 7-11 of paper no. 8) of the Examiner's office action after the Applicant noted the 37 C.F.R. §1.104 concerns in the response to paper no. 6. The Applicant appreciates the Examiner's cooperation in part.

However, the Examiner made paper no. 8 final, which places the Applicant at a great disadvantage in prosecuting the present application, because only after paper no. 8 were some of the particular parts being relied upon more clear to the Applicant. This is especially important since, some of the parts were inconsistently applied in the rejection and only through the disclosure of the particular parts being relied upon was the inconsistency seen.

Specifically for example, on page 8 of paper no. 8, the Examiner told the Applicant, "Therefore, Cheney teaches an outputting unit (Fig. 5)..." Figure 5 has only the 2:1 multiplexer MUX 202 and the OSD blend. However, on page 10 of paper no. 8, the Examiner stated that the outputting unit is the television ("...a signal is output from the outputting unit such as a television.")

Furthermore, in paper no. 8, page 10, the Examiner stated that the multiplexer MUX 202

(earlier mentioned as being the outputting unit) or the D/A converter of figure 2 is the signal conversion unit which is separate from the outputting unit.

Furthermore, the Examiner has changed his position as to what he considers is the outputting unit. In paper no. 6, the Examiner used figure 5 for the rejection, but in paper no. 8, the Examiner used all of figures 2-5 and col. 7, lines 1-37 which covers both figures 4 and 5. Figures 2-5 has a wide variety of elements, which as seen above, the Examiner inconsistently used different elements. Therefore, a clear issue has not been developed between the Examiner and the Applicant.

As mentioned in MPEP §706.07, “ Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”


The Applicant would greatly appreciate the Examiner's cooperation on this regard in order to provide a full an fair hearing for the Applicant.

RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

- A. Reconsider the finality of the rejection of the last Office action (Paper No. 8);
- B. Withdraw the finality of the last Office action (Paper No. 8);
- C. Require the Examiner to provide Applicant with clarification of the rejection in the last Office action (Paper No. 8); and
- D. Grant such other and further relief as justice may require.

Respectfully submitted,


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Folio: P56597
Date: 16 March 2004
I.D.: REB/SS